DISCUSSION OF THE AMENDMENT

Claims 1-15 have all been canceled and replaced with new, and narrower, Claims 16-37.

Claims 16-24 are based on Claims 2-4, 8-11, 13 and 15, respectively, except that Claim 22 is supported in the specification at page 9, line 7. Claim 25 is based on Claim 1. Support for the definition of R^4 is found in the specification at page 8, lines 12-14. Claims 26-34 correspond to Claims 3, 6-11, 13 and 15, respectively. Claim 35 is drawn to the elected species of Example 54. Claims 36 and 37 are drawn to the elected species for a specific disease.

No new matter is believed to have been added by the above amendment. Claims 16-37 are now pending in the application.

REMARKS

The rejection of Claims 1-3, 5 and 10-13 under 35 U.S.C. § 102(a) as anticipated by *J. Org. Chem*,, 2003, 68-4527-4530, published on web 05/25/2003 (Wagner et al), is respectfully traversed. The Examiner relies on compounds in Table 2 therein, wherein R^3 is OH or F, R^2 is methyl and R^4 is p-F-phenyl. Such compounds are now excluded by the present claims. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-13 and 15 under 35 U.S.C. § 103(a) as unpatentable over the "combined teachings" of Wagner et al, US 6,432,988 (Laufer et al) and US 6,040,320 (Beers et al), is respectfully traversed. Despite the above-quoted term, the Examiner has applied each reference individually, without any discussion of how they would be combined by one of ordinary skill in the art. Thus, the following traversal is based on the rejection as argued by the Examiner in the text of the rejection.

The deficiencies of Wagner et al have been discussed above. In this rejection, the Examiner does not indicate the extent of reliance on Wagner et al. Nevertheless, Applicants intend to file a certified English translation of Applicants' German priority application DE 10238045.7, filed August 20, 2002. Once filed, the Examiner is respectfully requested to find that Applicants are entitled to that filing date under 35 U.S.C. § 119. Accordingly, Wagner et al is not prior art herein.

To the extent the Examiner finds that all of the presently-claimed subject matter is not entitled to the § 119 priority date, Applicants note that Wagner et al is concerned with identification of regio isomers which occur due to the substituent at one of the imidazole nitrogen atoms. Compound 1 is used as a starting material for the alkylation of the nitrogen atom in the imidazole ring, as disclosed, for example, in Scheme 4 at page 4529. The only relevant compound for which a pharmacological activity is reported in Wagner et al, is said Compound 1. See Figure 1 on page 4528. However, Wagner et al provides no motivation to

modify said Compound 1 in any way. In addition, the newly-submitted Albrecht Declaration shows that representative compounds according to the present invention exhibit surprisingly higher activity compared to said Compound 1, which is Compound No. 24 in the table attached to the Declaration. More specifically, the table contains pharmacological data obtained by means of a test method described therein. The higher the values given in the table, the more active are the compounds as inhibitors of p38 MAP kinase, which is indicative of an anti-inflammatory effect. Indeed, Wagner et al confirms the acceptance of this test by the art (paragraph after the abstract at page 4527). As can be seen, the compounds, which are all within the scope of new Claim 25, exhibit a surprising better activity compared to Compound No. 24. (Compound No. 24 is listed under "Compounds of the invention" in the table because, while not within the scope of new independent Claim 25, it is within the scope of new independent Claim 16.)

Laufer et al discloses 4-heteroaryl-5-phenylimidazole derivatives having a general formula I, wherein A is a straight-chain or branched, saturated or unsaturated alkylene chain having up to six carbon atoms (column 2, lines 42-43), and thus, the compound has a substituted phenylalkyl group attached to a sulfur atom. Substitutions on the phenyl group, must (since n is at least 1) include an R^1 group, which is defined as a C_{1-4}-alkylthio, C_{1-4}-alkylsulfinyl, C_{1-4}-alkylsulfonyl, sulfonamido or C_{1-4}-alkylcarbonyl (column 2, lines 44-45 and 49). The present claims, on the other hand, although R^2 may be aryl-C_1-C_4-alkyl, do not embrace the compounds of Laufer et al. No motivation is provided to modify the R^1 group of Laufer et al's compounds. In addition, the newly-submitted Albrecht Declaration shows that representative compounds according to the present invention exhibit surprisingly higher activity compared to representative compounds of Laufer et al.

Beers et al discloses 2-substituted imidazoles having a formula I, wherein R_1 may be an unsubstituted heteroaryl (column 2, lines 48-49) and R_2 may be a substituted heteroaryl,

wherein the substituent is a C_{1-5}-alkyl or halogen (column 2, lines 55-60). In the presently-claimed compounds, the heteroaryl group, i.e., the 4-pyridyl group, is necessarily substituted by R^3, which is neither alkyl nor halogen. There is no disclosure or suggestion in Beers et al to modify their disclosed compounds.

For all the above reasons, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-13 and 15 on the ground of nonstatutory obviousness-type double patenting over Claims 1-8, 10, 13 and 14 of Laufer et al, is respectfully traversed. The claims of Laufer et al are no more pertinent than the complete disclosure, discussed above. There is no overlap between the present claims and those of Laufer et al, nor is there any suggestion to modify the compounds claimed in Laufer et al. Accordingly, it is respectfully requested that this rejection be withdrawn.

The provisional rejection of Claims 1-13 and 15 on the ground of nonstatutory obviousness-type double patenting over Claims 1-17 of copending Application No. 10/514,911 (copending application), is respectfully traversed. The Examiner is respectfully requested to hold the rejection in abeyance until the present claims are found to be allowable but for this rejection or the copending application has been patented. See M.P.E.P. 822.01.

For all the above reasons, it is respectfully requested that the provisional rejection be held in abeyance, if not withdrawn.

The rejection of Claim 15 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is respectfully traversed. It is respectfully submitted that the data described in the specification at page 29 herein in Table 1 are based on well-established *in vitro* tests for predicting activity against inflammatory disorders in which TNF-α and IL-β are involved, such as rheumatoid arthritis. While the Examiner purports to list the so-called *Wands* factors, nevertheless, the Examiner has not convincingly indicated why the results in said Table, or the description generally in the specification, would not enable a

person skilled in the art to treat inflammatory disorders of the type recited in the claims. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite, is respectfully traversed. Indeed, the rejection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

The objection to Claim 2 is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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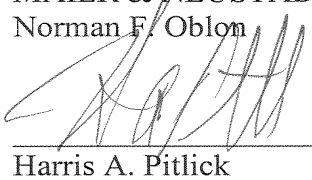

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